



Modified 02-03

PTO/SB/21 (01-03)
Approved for use through 9/30/00. OMB 0651-0031
Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

pbs

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application / Conf. No.	09/839,041 / 3626
	Filing Date	April 19, 2001
	First Named Inventor	Michael D. Nelson
	Examiner Name	Andrew J. Fischer
	Art Unit	3627
Mail Stop: AMENDMENT	Patent No.	
Express Mail Receipt No.	Attorney Docket Number	X-783 US
Total Number of Pages in This Submission		

RECEIVED
OCT 20 2004
GROUP 3600

ENCLOSURES (check all that apply)		
<input type="checkbox"/> Fee Transmittal Form	<input type="checkbox"/> Assignment Papers (with Recordation Cover Sheet)	<input type="checkbox"/> After Allowance Communication to
<input checked="" type="checkbox"/> Amendment / Reply	<input type="checkbox"/> Declaration / Oath	<input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences
<input type="checkbox"/> Preliminary Amendment	<input type="checkbox"/> Drawing(s)	<input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief)
<input type="checkbox"/> After Final	<input type="checkbox"/> Licensing-related Papers	<input type="checkbox"/> Status Letter
<input type="checkbox"/> Affidavit(s)/declaration(s)	<input type="checkbox"/> Petition -	<input checked="" type="checkbox"/> Return Receipt Postcard
<input type="checkbox"/> Extension of Time Request	<input type="checkbox"/> To Convert a Provisional Application	<input type="checkbox"/> Other Enclosure(s) (please identify below):
<input type="checkbox"/> Change Status to LARGE ENTITY	<input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address	
<input type="checkbox"/> Express Abandonment Request	<input type="checkbox"/> Terminal Disclaimer	
<input type="checkbox"/> Information Disclosure Statement	<input type="checkbox"/> Request for Refund	
<input type="checkbox"/> Substitute PTO-1449(s) IDS by Applicant (PTO/SB/08A)		
<input type="checkbox"/> Certified Copy of Priority Document(s)		
<input type="checkbox"/> Response to Missing Parts/Incomplete Application		
<input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53		
Remarks		
Response to Restriction Requirement		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Customer Number	24309 (Customer Number)	Reg. Number 40,941
Attn:	Lois D. Cartier	
Signature		
Date	October 12, 2004	Charge any additional fees required/credit any overpayment to our Deposit Account Number: 24-0040

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450 on this date October 12, 2004			
Typed or Printed Name	Pat Slaback		
Signature		Date	October 12, 2004

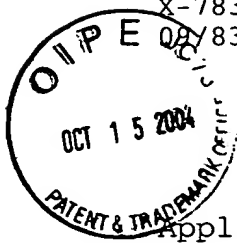
This collection of information is required by 37 CFR 1.17 and 1.27. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, Virginia 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450.

41

X-783 US
09/839,041

PATENT
Conf. No. 3626

3627



IN THE UNITED STATES PATENT OFFICE

Applicant: Michael D. Nelson
Assignee: Xilinx, Inc.
Title: Method for Storing and Shipping Programmable ASSP Devices
Serial No.: 09/839,041 Filing Date: 4/19/2001
Examiner: Andrew J. Fisher Art Unit: 3627
Docket No.: X-783 US Conf. No.: 3626

Mail Stop AMENDMENT
COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, VA 22313-1450

RECEIVED

OCT 20 2004

RESPONSE TO RESTRICTION REQUIREMENT

GROUP 3600

Dear Sir:

In response to the Restriction Requirement mailed September 27, 2004, Applicant provisionally elects with traverse to prosecute Group II: Claims 11-23.

However, Applicant respectfully traverses the restriction requirement on the grounds that the inventions as presently grouped are not patentably distinct. For example, Applicant respectfully notes that Claims 11 and 29 are almost identical, except that Claim 11 is drawn to a method and Claim 29 is drawn to an apparatus. Therefore, the process for using the product as claimed in Claim 11 cannot be practiced with a materially different product from that claimed in Claim 29.

The Restriction Requirement states:

4. Inventions II and IV are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP 806.05(e)). In this case, the process can be practiced by a materially different apparatus--one that does not require a means for pulling.

Applicant respectfully notes that Claim 29, which describes the apparatus, specifically states that the apparatus includes "means for pulling specified volumes of un-programmed ICs from inventory in response to an order from a customer". Claim 11, which describes the corresponding process, specifically states that the process includes: "pulling specified volumes of un-programmed ICs from inventory in response to an order from a customer". Therefore, Applicant is confused by the Examiner's assertion that the process can be practiced by an apparatus that does not require a means for pulling.

Applicant respectfully submits that Claims 11-23 (now designated as Group II) and Claims 29-42 (now designated as Group IV) quite clearly do not qualify as unrelated inventions.

However, Applicant respectfully submits that the following grouping of claims results in three patentably distinct inventions.

Proposed Group I: Claims 1-10
Proposed Group II: Claims 11-23 and 29-42
Proposed Group III: Claims 24-28

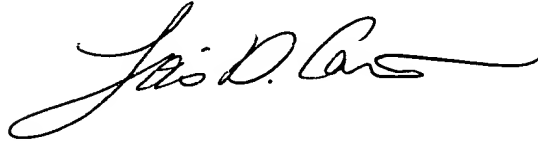
Applicant respectfully requests that the Examiner regroup the claims into new groups as proposed by Applicant. If the claims are so regrouped, Applicant will elect Group II (Claims 11-23 and 29-42) for prosecution, without traverse.

X-783 US
09/839,041

PATENT
Conf. No. 3626

If the Examiner has any questions, the Examiner is requested to telephone Applicant's agent at 408-879-4604.

Respectfully submitted,



Lois D. Cartier
Agent for Applicant
Reg. No. 40,941

I hereby certify that this correspondence is being deposited with the United States Postal Service as **first class mail** in an envelope addressed to: Commissioner for Patents, P.O. Box 1450 Alexandria, VA 22313-1450, on October 12, 2004

Pat Slaback
Name

Pat Slaback
Signature